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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,712	12/11/2001	Mark Paine	9623/378	1404

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BRINKS HOFER GILSON & LIONE / YAHOO! OVERTURE  
P.O. BOX 10395  
CHICAGO, IL 60610

EXAMINER

LEROUX, ETIENNE PIERRE

ART UNIT PAPER NUMBER

2161

DATE MAILED: 01/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/020,712

Applicant(s)

PAINE ET AL.

Examiner

Etienne P LeRoux

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 66-84 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 66-84 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Claim Status:***

Claims 66-84 are pending; claims 1-65 have been cancelled. Claims 66-84 are rejected as detailed below.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 66-71 and 73-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat No 6,421,675 issued to Ryan et al (hereafter Ryan) in view of US Pat No 6,289,341 issued to Barney (hereafter Barney).

**Claims 66, 79 and 80:**

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Ryan discloses::

- (a) obtaining a set of potential search terms for acceptance by a new information provider who is adding items to the database [keyword 52, Fig 2, col 5, line 13]
- (c) computing an estimated rating for the each potential search term for the new information provider [Crawler key-word list, col 7, line 63-col 8, line 5]
- (d) sorting the potential search terms according to the computed estimated ratings[
- (e) presenting to the new information provider on an output device the sorted potential search terms [Crawler key-word list, col 7, line 63-col 8, line 5]
- (f) receiving from the new information provider at an input device an indication of accepted search terms [Surfer keyword list col 8, lines 15-20]
- (g) repeating (b) through (e) until completion indication is received from the new information provider [successive surfer key-word lists, col 8, line 30]
- (h) storing the accepted search terms in the database for the new information provider upon receipt of the completion indicator [keyword table, 164, Fig 4, col 11, lines 20-40].

Ryan discloses the elements of the claimed invention as noted above but does not disclose (b) computing correlations between the potential search terms for the new information provider and search terms of other information providers stored in the database. Barney discloses (b) computing correlations between the potential search terms for the new information provider and search terms of other information providers stored in the database [col 5, lines 20-35]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ryan to include (b) computing correlations between the potential search terms for the new information provider and search terms of other information providers stored in the

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database as taught by Barney for the purpose of making a statistical comparison between the potential search terms and the database comprising keywords generated from existing websites.

**Claims 67, 81 and 82:**

The combination of Ryan and Barney discloses the elements of claim 66 as noted above and furthermore, Ryan discloses receiving from the new information provider a website uniform resource locator and spidering the website [col 7, lines 60-65] associated with the website URL [col 6, lines 35-30] to obtain search terms for the set of potential search terms.

**Claim 68 and 83:**

The combination of Ryan and Barney discloses the elements of claims 66 and 67 as noted above and furthermore, Ryan discloses receiving data from pages of the website, recording potential search terms from the data and determining a quality metric for each potential search term [Surfer keyword list col 8, lines 15-20]

**Claim 69**

The combination of Ryan and Barney discloses the elements of claims 66 and 67 as noted above and furthermore discloses combining a rating based on the computed correlations and a rating based on the quality metric determined for each candidate search term [Barney, col 5, lines 20-35, Ryan Surfer keyword list col 8, lines 15-20]

**Claim 70 and 84:**

The combination of Ryan and Barney discloses the elements of claims 66-68 as noted above and furthermore, Ryan discloses sorting the candidate search terms according to a quality metric and adding the set of potential search terms only candidate search terms having a quality metric exceeding a threshold [key-word suggester, col 8, line 28]

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**Claim 71:**

The combination of Ryan and Barney discloses the elements of claims 66 as noted above and furthermore, Ryan discloses receiving data from one or more pages of the website and examining text from the one or more pages for candidate search terms [Crawler key-word list, col 7, line 63-col 8, line 5]

**Claim 73:**

The combination of Ryan and Barney discloses the elements of claims 66 and 71 as noted above and furthermore, Ryan discloses receiving a website URL comprises receiving the advertiser's URL as the web site URL [col 6, lines 35-30]

**Claim 74:**

The combination of Ryan and Barney discloses the elements of claims 66 and 71 as noted above and furthermore, Ryan discloses receiving the website from the advertiser [col 6, lines 35-30].

**Claim 75:**

The combination of Ryan discloses the elements of claim 66 as noted above and furthermore, discloses assigning ratings to search terms and computing a correlation between the advertiser and one or more of the other advertisers using the assigned ratings of advertiser search terms [Barney, [col 5, lines 20-35].

**Claim 76:**

The combination of Ryan and Barney discloses the elements of claims 66 and 75 as noted above and furthermore, Ryan discloses predicting a likelihood that a search term will be relevant to the advertiser [col 8, lines 25-30]

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**Claim 77:**

The combination of Ryan and Barney discloses the elements of claims 66, 75 and 76 as noted above and furthermore, Ryan discloses determining a quality metric for potential search terms and predicting relevance of the potential search terms based on the quality metric [Surfer keyword list col 8, lines 15-20]

**Claim 78:**

The combination of Ryan and Barney discloses the elements of claim 66 as noted above and furthermore, Ryan discloses wherein presenting the sorted potential search terms to the new information provider comprises sending the sorted potential search terms with a web page to the output device [Fig 1A, 38]

Claims 67, 72-74 and 80-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Ryan and Barney and further in view of US Pat No 6,078,916 to Culliss (hereafter Culliss).

**Claim 72:**

The combination of Ryan and Barney discloses the elements of claims 66 and 71 as noted above and furthermore, Ryan discloses examining substantially all text from the one or more pages but does not disclose examining meta tags from the one or more pages. Culliss discloses examining meta tags from the one or more pages [col 5, lines 15-20]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the

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combination of Ryan and Barney to include examining meta tags from the one or more pages as taught by Culliss for the purpose of attaching scores to each article.

### ***Response to Arguments***

Applicant's arguments filed 11/23/2005 with respect to claims 66-84 have been considered and found partially persuasive but are now moot in view of above new ground(s) of rejection.

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne P. LeRoux whose telephone number is (571) 272-4022. The examiner can normally be reached Monday through Friday between 8:00 am and 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on (571) 272-4023. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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Etienne LeRoux

1/19/2005

A handwritten signature in black ink, appearing to read "Etienne LeRoux", written diagonally across the page.